

### **REMARKS**

After entry of the instant Amendment, claims 1, 3-9, 12, 15, 16, and 19 remain in the application with claim 1 in independent form. Independent claim 1 has been amended to replace the phrase “can be” with the phrase “is” to clarify the scope of the invention claimed in independent claim 1. Claims 2, 10, 11, 13, 14, 17, 18, and 20 were previously cancelled. Claims 6-9 were previously withdrawn from consideration subject to possible rejoinder should independent claim 1 be allowed. No new claims have been added. No new subject matter has been added through the amendments to the instant claims.

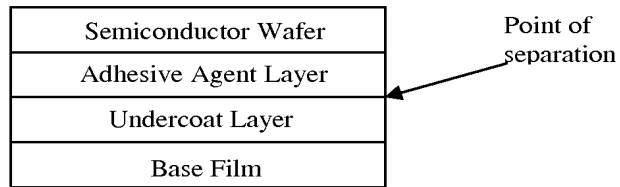
Claims 1, 3-5, 12, 15, 16, and 19 stand rejected under 35 U.S.C. §102(b) over European Patent App. No. 0 571 649 (hereinafter the EP ‘649 application).

In view of the amendment of independent claim 1 to replace the phrase “can be” with the word “is”, the Applicants respectfully submit that the instant rejections have been overcome for reasons as set forth below.

In response to the Applicants’ Amendment filed on March 27, 2008, in which independent claim 1 was amended to incorporate the elements of dependent claim 2, the Examiner focused on the phrase “can be” in the context of the claim language “wherein said silicone based adhesive agent layer can be stripped from said undercoat layer after bonding to said semiconductor wafer”. In particular, the Examiner opined that the phrase “can be” renders the limitation optional such that the limitation can be ignored for purposes of examination. While not intending to dwell on the Examiner’s interpretation of the phrase “can be” (given the fact that the Applicants have amended independent claim 1 to replace the phrase “can be” with the word “is”), the Applicants wish to clarify for the record that it is not believed that the instant amendments are necessary for

purposes of defining the instant invention over the teachings of the EP '649 application. More specifically, the Applicants respectfully submit that the Examiner should not have ignored the phrase "can be" but rather should have evaluated the claim limitation for what it fairly conveys to a person of ordinary skill in the pertinent art consistent with the treatment accorded to functional claim limitations. See MPEP 2173.05(g). While the Applicants surely appreciate that the phrase "can be" is oftentimes associated with optional limitations, the phrase as it was used in independent claim 1 prior to the instant amendment clearly does not convey an optional feature but rather conveys a capability possessed by the dicing/bonding sheet. Nevertheless, the Applicants have replaced the phrase "can be" with the word "is" to place the claim language in more robust form.

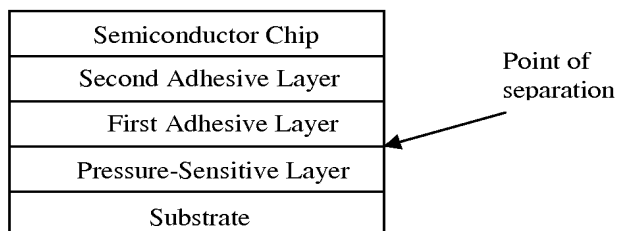
In view of the amendment to independent claim 1, the Applicants respectfully submit that the instant invention as claimed is clearly distinguished from the disclosure and teachings of the EP '649 application such that the rejections under 35 U.S.C. §102(b) are overcome. More specifically, because the phrase "can be" has been replaced with the word "is", the Examiner's rationale for ignoring the distinguishing features of the instant invention as claimed in independent claim 1 is overcome. As set forth in the Amendment filed on March 27, 2008, the EP '649 application fails to teach a dicing/bonding sheet as claimed in the instant claims **with an adhesive agent layer that is bonded to a semiconductor wafer and that is stripped from the undercoat layer after bonding to the semiconductor wafer**. For the Examiner's reference, the Applicants again provide an illustration of the structure of the claimed dicing/bonding sheet in the following schematic:



The stripping of the adhesive agent layer from the undercoat layer imparts structural features to the claimed dicing/bonding sheet and, in particular, to the adhesive agent layer, and such structural features cannot be ignored when comparing the instant claims to the teachings of the prior art. After all, an adhesive agent layer that is either not bonded to the semiconductor wafer **or** that cannot be stripped from the undercoat layer cannot satisfy each and every element of independent claim 1 as amended.

Turning to the teachings of the EP '649 application, the EP '649 application discloses a bonding sheet with a substrate, a pressure-sensitive layer bonded to the substrate, a first adhesive layer adhered to the pressure-sensitive layer, and a second adhesive layer adhered to the first adhesive layer. The second adhesive layer has an adhesive surface that is adhesively bonded to a semiconductor wafer (refer to column 2, line 47 to column 3, line 8 of the EP '649 application). Thus, to equate to the instantly claimed structure, **the first adhesive layer of the EP '649 application is comparable to the instantly claimed undercoat layer because the first adhesive layer is the layer that is disposed directly adjacent the second adhesive layer, on an opposite side of the second adhesive layer from the semiconductor wafer.** In effect, the EP '649 application includes **an additional layer** between the semiconductor wafer and the portion of the dicing/bonding sheet that is separated from the wafer after stripping. The EP '649

application does not teach a single layer that **both** bonds to the semiconductor wafer **and** is capable of separation from the rest of the dicing/bonding sheet. To illustrate the teachings of the EP '649 application as distinguished from the instant claims, the EP '649 application teaches the following structure:



Because the EP '649 application requires that **both** the first adhesive layer **and** the second adhesive layer remain with the semiconductor wafer after cutting and after stripping the pressure-sensitive layer and the substrate from the wafer, EP '649 does not teach each and every element of the instant independent claim 1 as amended and, therefore, cannot anticipate independent claim 1 as amended.

Furthermore, there is no basis for the Examiner to conclude that independent claim 1, as amended, is obvious over the teachings of the EP '649 application due to the fact that the invention of EP '649 would be inoperable absent the presence of both adhesive layers taught therein. As such, the Applicants respectfully submit that independent claim 1 is both novel and non-obvious and, thus, is in condition for allowance. The remaining claims each depend upon the novel and non-obvious features of independent claim 1 such that the Applicants respectfully submit that these claims are also in condition for allowance. Finally, the Applicants respectfully request rejoinder of withdrawn claims 6-9 upon allowance of independent claim 1, from which claims 6-9 depend.

This Amendment is timely filed, and is further filed with the appropriate fee for a Request for Continued Examination such that it is believed that no fees are presently due. However, the Commissioner is authorized to charge our deposit account no. 08-2789 for any additional fees or credit the account for any overpayment.

Respectfully submitted,

**HOWARD & HOWARD ATTORNEYS, P.C.**

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